

REMARKS

This Amendment is submitted prior to continued examination of the present application and is responsive to the official action dated May 15, 2007.

Claims 1-8, 10, and 12-24 were pending in the application. In the official action, claims 12-23 were withdrawn from consideration, and claims 1-8, 10, and 24 were rejected. In this Amendment, claim 1 has been amended. Claims 1-8, 10, and 24 thus remain for consideration.

Applicant submits that claims 1-8, 10, and 24 are in condition for allowance and requests withdrawal of the rejections in light of the following remarks.

§112 Rejection

Claim 1 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More particularly, claim 1 was rejected as lacking antecedent basis for the claim limitation: "on top of the first hot melt adhesive."

Applicant has amended claim 1 to substitute the language "on top of the first layer" for the language "on top of the first hot melt adhesive." Applicant submits that such amendment to claim 1 renders claim 1 compliant with §112. Accordingly, Applicant requests that the §112 rejection be withdrawn.

§103 Rejections

Claims 1-8, 10 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Miekka et al.* (U.S. Patent No. 6,540,865 in view of *Xie et al.* (U.S. Patent No. 6,503,620) and *Ugolick et al.* (U.S. Patent No. 5,993,961) or in further view of *Piacente et al.* (U.S. Patent No. 5,178,912).

Applicant submits that independent claim 1 is patentable over *Miekka, Xie, Ugolick and Piacente*.

Applicant's invention, as recited in claim 1, is directed toward a method for forming a colored tape. The tape formed by the method includes a base film having a first surface and a second surface. The first surface of the base film is covered with a mixture of laminating adhesive and coloring agent to form a first layer on the first surface. On top of the first layer, hot melt adhesive is applied to form a second layer.

The claim recites that "the first layer serves as a non-pressure-sensitive adhesive which is bonded to the first surface of the base film" and that "there is no release coating present between the first layer and the first surface of the base film." For supporting disclosure, the Examiner is referred to the specification at, for example, paragraphs [0048] to [0054].

Neither *Miekka, Xie, Ugolick* nor *Piacente* discloses the use of a mixture of laminating adhesive and coloring agent as a non-pressure-sensitive layer that bonds to a base film. Moreover, neither *Miekka, Xie, Ugolick* nor *Piacente* discloses bonding of such a layer to a base film without the presence of a release coating between the layer and the base film. Applicant wishes to comment on the *Miekka* reference in particular.

The Examiner asserts that "the pressure sensitive adhesive [] of *Miekka et al.* that is applied prior to the hot melt adhesive acts as the [sic] laminating adhesive" (Official Action page 2, lines 12-14). However, Applicant notes that the pressure sensitive adhesive (PSA) of *Miekka* can not be substituted for Applicant's laminating adhesive. For one, Applicant's claim specifies that the mixture of laminating adhesive and coloring agent forms a non-pressure-sensitive adhesive layer on the base film. *Miekka's* PSA can not form such a layer since *Miekka's* PSA is, by definition, pressure-sensitive. Further, Applicant's claim specifies that the mixture

of laminating adhesive and coloring agent is bonded to the base film. By contrast, *Miekka's* PSA does not bond to the base film. Rather, *Miekka's* PSA is designed for release from the base film. (See e.g. *Miekka* col. 32, line 60 - col. 33, line 18). Accordingly, *Miekka* provides a release coating on the surface of the base film. The release coating provides an additional layer between the PSA and the base film for purposes of preventing bonding between the PSA and the base film. (See e.g. *Miekka* col. 4, lines 49-52; and col. 7, lines 24-40).

Applicant's claim excludes a release coating such as the release coating required by *Miekka*.

Since neither *Miekka*, *Xie*, *Ugolick* nor *Piacente* discloses the use of a mixture of laminating adhesive and coloring agent as a non-pressure-sensitive layer that bonds to a base film, Applicant believes that claim 1 is patentable over *Miekka*, *Xie*, *Ugolick* and *Piacente* - taken either alone or in combination - for at least this reason.

Since dependent claims inherit the limitations of their respective base claims, Applicant believes that dependent claims 2-8, 10, and 24 are patentable over *Miekka*, *Xie*, *Ugolick* and *Piacente* for at least the same reasons discussed in connection with claim 1.

Applicant respectfully submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited. If any issues remain, or if the Examiner has any further suggestions, he/she is invited to telephone the undersigned at (908) 654-5000.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 12-1095.

The Examiner's consideration of this matter is gratefully acknowledged.

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Respectfully submitted,

By 

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